

Claims 1-14 provides for the use of compositions comprising polyester and articles, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

(Paper 6, p. 2).

Claim 1, a process of making articles from aliphatic polyester resins, recites the positive step of manufacturing the articles from the particular resins described by the claim. Applicants respectfully submit that claims 1-14 are now in proper format and the rejection should be withdrawn.

#### ***Claim Rejections - 35 U.S.C. § 101***

The Examiner rejected claims 1-14 under 35 U.S.C. 101 as not conforming to the definition of a proper process claim. The Examiner asserted that:

...[B]ecause the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101.

(Paper 6, p.2).

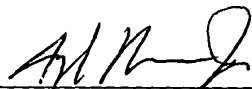
As discussed above, claim 1 recites the positive step of manufacturing the articles from the particular resins described by the claim. Applicants respectfully submit that claims 1-14 are now in proper format and the rejection should be withdrawn.

Applicants point out that new claim 15 conforms to the requirements under 35 U.S.C. 101 for an article of manufacture claim.

#### **CONCLUSION**


In view of the foregoing, favorable action on the merits, including withdrawal of the rejections, and allowance of all the claims, is respectfully requested. If the Examiner has any questions regarding this paper, please contact one of the undersigned attorneys.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231, on October 1, 2002.



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## Marked-Up Version of Claims

Please NOTE: Because brackets (e.g., "[ ]" ) are used in the claim to designate recurring polymer units, brackets and strikethrough (e.g., "[~~strikethrough~~"]") are used to designate a deletion, while insertions are underlined (e.g., "underlined").

--1. (Amended) A method of making a biodegradable article having a permeability to water vapor of less than 350 gx30µm/m<sup>2</sup> per day at 38°C and 90% RH [Use of compositions] comprising:

[, in quantities sufficient to ensure the required performance,] manufacturing articles from aliphatic polyester resin,

wherein said aliphatic polyester resin further comprises [with mean numeral molecular weights greater than 1000 formed by]

a) recurring units X = [O-(CH<sub>2</sub>)<sub>n</sub>-OCO-(CH<sub>2</sub>)<sub>m</sub>-CO] and/or Y = [O-(CH<sub>2</sub>)<sub>k</sub>-CO], where the half-sum of n + m is equal to or greater than 6 and k is a number equal to or greater than 6, or by copolymers comprising units and/or sequences having the formula x<sub>i</sub>[O-(CH<sub>2</sub>)<sub>n<sub>i</sub></sub>-OCO-(CH<sub>2</sub>)<sub>m<sub>i</sub></sub>-CO]; y<sub>j</sub>[O-(CH<sub>2</sub>)<sub>k<sub>j</sub></sub>-CO] where: i, j = 1-5;

n<sub>i</sub> = 2-22; m<sub>i</sub> = 0-20; k<sub>j</sub> = 1-21;  $\sum_{i=1}^5 x_i + \sum_{j=1}^5 y_j = 1$  and x<sub>i</sub> and y<sub>j</sub> vary between 0 and

1 and are molar fractions of the various units such that  $\sum_{i=1}^5 x_i \cdot \left(\frac{n_i+m_i}{2}\right) + \sum_{j=1}^5 y_j \cdot k_j \geq 6,$

or

b) [by] recurring units Z=[O-(CH<sub>2</sub>)<sub>a</sub>-OCO-(CH<sub>2</sub>)<sub>b</sub>-CO] where a = 2-3, b = 7-11,

and

has an intrinsic viscosity (in chloroform at 25 °C) greater than 0.7 and up to 2.5 dl/g, and a biodegradability such that, under composting conditions, a 30 µm film of said resin shows a decomposition of less than 10% in 14 days and more than 90% in six months [present in sufficient quantity to ensure good barrier properties and biodegradability of the resins for the manufacture of articles having a permeability to water vapour of less than 350 gx30µm/m<sup>2</sup> per day at 38°C and 90% RH, said articles showing decomposition in composting conditions on 30µm film of less than 10% in 14 days and more than 90% in six months].

--15. (Amended) An article of manufacture [~~Use of compositions~~] comprising:  
~~[, in quantities sufficient to ensure the required performance,]~~ a biodegradable article  
having a permeability to water vapor of less than 350 gx30µm/m<sup>2</sup> per day at 38°C and 90% RH  
manufactured from aliphatic polyester resin,

wherein said aliphatic polyester resin further comprises [~~with mean numeral molecular-  
weights greater than 1000 formed by]~~

a) recurring units  $X = [O-(CH_2)_n-OCO-(CH_2)_m-CO]$  and/or  $Y = [O-(CH_2)_k-CO]$ ,  
 where the half-sum of  $n + m$  is equal to or greater than 6 and  $k$  is a number equal  
 to or greater than 6, or by copolymers comprising units and/or sequences having  
 the formula  $x_i[O-(CH_2)_{n_i}-OCO-(CH_2)_{m_i}-CO]$ ;  $y_j[O-(CH_2)_{k_j}-CO]$  where:  $i, j = 1-5$ ;

$n_i = 2-22$ ;  $m_i = 0-20$ ;  $k_j = 1-21$ ;  $\sum_{i=1}^5 x_i + \sum_{j=1}^5 y_j = 1$  and  $x_i$  and  $y_j$  vary between 0 and

1 and are molar fractions of the various units such that  $\sum_{i=1}^5 x_i \cdot \left(\frac{n_i+m_i}{2}\right) + \sum_{j=1}^5 y_j \cdot k_j \geq 6$ ,

or

b) [by] recurring units  $Z=[O-(CH_2)_a-OCO-(CH_2)_b-CO]$  where  $a = 2-3$ ,  $b = 7-11$ ,

and

has an intrinsic viscosity (in chloroform at 25 °C) greater than 0.7 and up to 2.5 dl/g, and a  
biodegradability such that, under composting conditions, a 30 µm film of said resin shows a  
decomposition of less than 10% in 14 days and more than 90% in six months [~~present in-~~  
~~sufficient quantity to ensure good barrier properties and biodegradability of the resins for the~~  
~~manufacture of articles having a permeability to water vapour of less than 350 gx30µm/m<sup>2</sup> per~~  
~~day at 38°C and 90% RH, said articles showing decomposition in composting conditions on~~  
~~30µm film of less than 10% in 14 days and more than 90% in six months]~~.